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EXAMINER	
LIU, LIN	

ART UNIT	PAPER NUMBER
2445	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/777,571	HILBERT ET AL.	
	Examiner	Art Unit	
	LIN LIU	2445	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 January 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12 and 14-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12 AND 14-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This office action is responsive to communications filed on 01/06/2009

Claims 1-12 and 14-30 are pending and have been examined.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/06/2009 has been entered.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims **1-4, 12 and 14-23, and 25-28** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hanna et al. (Patent no.: US 7,054,905 B1)** in view of **Arnold (Patent no. US 6,275,848 B1)** and **Tsai (patent no.: US 6,839,741 B1).**

With respect to **claim 19,** Hanna teaches a system for processing electronic mail messages, the system comprising: a message parser configured to (Hanna: fig. 2):

accept an electronic mail message, the electronic mail message including a file attachment (Hanna: fig. 2, col. 4, lines 18-24, noted that email server 108 accepts email message including attachment.);

in response to a positive determination, store the file attachment in an attachment location (Hanna: col. 4, lines 29-37, noted that the attachment is stored in file server 111); and

insert an attachment reference associated with the attachment location wherein the attachment reference causes submission of validation information to an attachment server storing the attachment location (Hanna: col. 5, lines 26-31 and lines 57-67, noted that URL address of the attachment is sent to the recipient with the modified message.);

embed a security token into the electronic mail message, wherein the security token specifies a security credential that would be transmitted to the

attachment server when said attachment reference is utilized (Hanna: col. 5, lines 8-16 and lines 57-67, noted the authentication mechanisms); and

a attachment reference module that manages the generation of the attachment reference (Hanna: col. 5, lines 26-31, insertion of URL reference to the attachment file); and

the attachment server that stores the file attachment in the attachment location, wherein the attachment server receives a retrieval request from a recipient (Hanna: col. 5, lines 1-16).

However, Hanna does not explicitly teach a method of determining whether to remove the file attachment; and a method of performing transduction on the file attachment prior to providing the file attachment to the recipient, wherein the transduction is performed by the attachment server modifying a format of said attachment into a different format that enables the recipient to access the attachment, streaming the attachment to said recipient, or translating text contained in said attachment.

In the same field of endeavor, Arnold teaches a method of determining whether to remove the file attachment (Arnold: fig, 2 steps 206-208, and col. 4, lines 6-24, noted that detachment rule is applied).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the method of applying a detachment rules of an attachment file as taught by Arnold in Hanna's invention in order to apply the filter criteria in detaching the file attachment from the email message before sending the message to the recipients. The advantage of such

method is that it avoids having SMTP in handling multiple large attachments and preventing recipient's email applicant from crashing (Arnold: col. 1, lines 39-61).

In the same field of endeavor, Tsai teaches a method of performing transduction on the file attachment prior to providing the file attachment to the recipient, wherein the transduction is performed by the attachment server modifying a format of said attachment into a different format that enables the recipient to access the attachment, streaming the attachment to said recipient, or translating text contained in said attachment (Tsai: col. 4, line 61 to col. 5 line 8, and col. 6, lines 30-57, noted that the server converts the attachment file into a format that is viewable and downloadable by a recipient.).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the method of performing transduction on the file attachment prior to providing the file attachment to the recipient as taught by Tsai in the combined method of Hanna-Arnold's invention in order offload the processing work of the attachment file to the file server and reduce the workload on the recipient.

With respect to **claim 20,** Hanna teaches the system of claim 19 wherein the attachment reference is a hyperlink (Hanna: col. 5, lines 26-31, URL reference).

With respect to **claim 21,** Hanna teaches all the claimed limitations, except that she does not explicitly teach a method of determining a size of the file attachment.

In the same field of endeavor, Arnold teaches determining a size of the file attachment (Arnold: col. 4, lines 58-67).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the method of applying a detachment a size of the file attachment as taught by Arnold in Hanna's invention in order to determine whether, or how long, the attachment shall remain on the server (Arnold: col. 4, lines 58-67).

With respect to **claim 22,** Hanna teaches the system of claim 19, wherein determining whether to remove the file attachment comprises determining an identity of a recipient of the electronic mail message (Hanna: fig. 2, col. 4 lines 17-37, it is an inherent feature to identify the recipient's email address.).

With respect to **claim 23,** Hanna teaches a method of determining a type of the file attachment (Hanna: col. 4, lines 25-28).

With respect to **claim 25,** Hanna teaches the system of claim 24, wherein the executable configured to prompts a recipient for validation information and then submits the received validation information to the server storing the attachment location (Hanna: col. 5, lines 8-16 & lines 57-67).

With respect to **claim 26,** Hanna teaches the system of claim 19, wherein the attachment is a media file (Hanna: col. 4, lines 25-28, noted the graphical image) and the system streams the file attachment to a recipient (Hanna: col. 4, lines 37-40).

With respect to **claim 27,** Hanna teaches the file system of claim 19, wherein the attachment is a document including text and the system translates the text (Hanna: col. 4, lines 25-28, document file).

With respect to **claim 28,** Hanna teaches the system of claim 19, wherein the server storing the file attachment prompts a recipient for validation information when the recipient attempts to retrieve the file attachment (Hanna: col. 5, lines 8-16 & lines 57-67).

In regard to **claims 1-3, 12 and 14-18,** the limitations of these claims are substantially the same as those in claims 19-23, and 25-28. Therefore the same rationale for rejecting claims 19-23, and 25-28 is used to reject claims 1-3, 12 and 14-18. By this rationale **claims 1-3, 12 and 14-18** are rejected.

With respect to **claim 4,** Hanna teaches the method of claim 1, further comprising generating a low bandwidth version of the file attachment upon request (Hanna: col. 4, lines 41-50 & col. 6, lines 6-11).

6. Claims 5-11, 24 and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hanna et al. (Patent no.: US 7,054,905 B1)** in view of **Arnold (Patent no. US 6,275,848 B1)** and **Tsai (patent no.: US 6,839,741 B1)**, and further in view of **Le Pennec et al. (PGPUB: US 2005/0076082 A1).**

With respect to **claim 5,** Hanna teaches a method for processing electronic mail messages, the method comprising:

accepting an electronic mail message, the electronic mail message including a file attachment (Hanna: fig. 2, col. 4, lines 18-24, noted that email server 108 accepts email message including attachment.);

in response to a positive determination, storing the file attachment in an attachment location (Hanna: col. 4, lines 29-37, noted that the attachment is stored in file server 111); and

inserting in the message, an attachment reference that automatically submits validation information to a server storing the file attachment and retrieves the file attachment from the attachment location on an attachment server (Hanna: col. 5, lines 26-31 and lines 57-67, noted that URL address of the attachment is sent to the recipient with the modified message.);

embedding a security token into the electronic mail message, wherein the security token specifies a security credential that would be transmitted to the attachment server when said executable file is utilized (Hanna: col. 5, lines 8-16 and lines 57-67, noted the authentication mechanisms).

However, Hanna does not explicitly teach a method of determining whether to remove the file attachment; a method of inserting an executable file reference associated with the attachment location; and a method of performing transduction on the file attachment prior to providing the file attachment to the recipient, wherein the transduction is performed by the attachment server modifying a format of said attachment into a different format that enables the recipient to access the attachment, streaming the attachment to said recipient, or translating text contained in said attachment.

In the same field of endeavor, Arnold teaches a method of determining whether to remove the file attachment (Arnold: fig, 2 steps 206-208, and col. 4, lines 6-24, noted that detachment rule is applied).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the method of applying a detachment rules of an attachment file as taught by Arnold in Hanna's invention in order to apply the filter criteria in detaching the file attachment from the email message before sending the message to the recipients. The advantage of such method is that it avoids having SMTP in handling multiple large attachments and preventing recipient's email applicant from crashing (Arnold: col. 1, lines 39-61).

In the same field of endeavor, Le Pennec teaches a method of inserting an executable file reference associated with the attachment location (Le Pennec: page 2, paragraphs 27 & 32, and page 3, paragraphs 34 & 37, noted the executable file is attached to the original email message to automatically retrieving the original file attachment).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to substitute the method of attaching an executable data file as taught by Le Pennec in the combined method of Hanna-Arnold's invention in order to download the original attachment files from the server. The advantage to integrate such method is that it bypasses the file attachment size limitation, and avoids sending large files and overloading the user's mailbox (Le Pennec page 1, paragraphs 10-11).

In the same field of endeavor, Tsai teaches a method of performing transduction on the file attachment prior to providing the file attachment to the recipient, wherein the transduction is performed by the attachment server modifying a format of said attachment into a different format that enables the recipient to access the attachment, streaming the attachment to said recipient, or translating text contained in said attachment (Tsai: col. 4, line 61 to col. 5 line 8, and col. 6, lines 30-57, noted that the server converts the attachment file into a format that is viewable and downloadable by a recipient.).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the method of performing transduction on the file attachment prior to providing the file attachment to the recipient as taught by Tsai in the combined method of Hanna-Arnold- Le Pennec's invention in order offload the processing work of the attachment file to the file server and reduce the workload on the recipient.

With respect to **claims 6 and 7**, Hanna teaches all of the claimed limitations except that he does not explicitly teach a method of prompting validation information which enables the retrieval of the file attachment from the attachment location.

In the same field of endeavor, Le Pennec teaches a method of prompting validation information which enables the retrieval of the file attachment from the attachment location (Le Pennec: page 2, paragraphs 27 & 32, and page 3, paragraphs 34 & 37). Same motivation used in claim 5 applies equally as well to claims 6 and 7.

With respect to **claim 8**, Hanna teaches the method of claim 5, further comprising generating a low bandwidth version of the file attachment upon request (Hanna: col. 4, lines 41-50 & col. 6, lines 6-11).

With respect to **claim 9**, Hanna teaches all of the claimed limitations except that he does not explicitly teach a method of converting the file to a commonly usable format.

In the same field of endeavor, Tsai teaches a method of converting the file to a commonly usable format (Tsai: col. 4, line 61 to col. 5 line 8, and col. 6, lines 30-57, noted that the server converts the attachment file into a format that is viewable and downloadable by a recipient.). Same motivation used in claim 5 applies equally as well to claim 9.

With respect to **claim 10**, Hanna teaches the method of claim 5, wherein determining whether to remove the file attachment comprises determining an identity of a recipient of the electronic mail message (Hanna: fig. 2, col. 4 lines 17-37).

With respect to **claim 11**, Hanna teaches the method of claim 5, wherein determining whether to remove the file attachment comprises determining a domain of a recipient email address (Hanna: fig. 2, col. 4 lines 17-37).

With respect to **claims 29 and 30**, the combined method of Hanna-Arnold-Tsai teaches attaching a URL reference to the email message (Hanna: col. 5, lines 26-31, URL reference). However, Hanna-Arnold-Tsai does not explicitly teach a method of attaching a data file as attachment reference, and wherein the

data file is configured to enable an application stored on a recipient computer to retrieve the attachment from the server storing the attachment.

In the same field of endeavor, Le Pennec teaches a method of attaching a data file as attachment reference, and wherein the data file is configured to enable an application stored on a recipient computer to retrieve the attachment from the server storing the attachment (Le Pennec: page 2, paragraph 27, noted the executable file is attached to the original email message).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to substitute the method of attaching an executable data file as taught by Le Pennec in the combined method of Hanna-Arnold-Tsai's invention in order to download the original attachment files from the server. The advantage to integrate such method is that it bypasses the file attachment size limitation, and avoids sending large files and overloading the user's mailbox (Le Pennec page 1, paragraphs 10-11).

In regard to **claim 24,** the limitation of this claim is substantially the same as those in claims 29-30. Therefore the same rationale for rejecting claims 29-30 is used to reject claim 24. By this rationale **claim 24 is** rejected.

Response to Arguments

7. Applicant's arguments with respect to claims 1-12 and 14-30 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LIN LIU whose telephone number is (571)270-1447. The examiner can normally be reached on Monday - Friday, 7:30am - 5:00pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton B. Burgess can be reached on (571)-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lin Liu/
Examiner, Art Unit 2445

/Patrice Winder/
Primary Examiner, Art Unit 2445